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EXAMINER

ENGLAND, DAVID E

ART UNIT

PAPER NUMBER

2143

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Please find below and/or attached an Office communication concerning this application or proceeding.

24

Office Action Summary

Application No.

09/247,502

Applicant(s)

BATES ET AL. 

Examiner

David E. England

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 9, 11 - 22 and 25 - 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 9, 11 - 22 and 25 - 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 9, 11 – 22 and 25 – 36 are presented for examination.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation of, “notifying the first user of the location of another hypertext document currently being viewed by a third user,” is not disclosed in the specification.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

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122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by MacNaughton et al. U. S. Patent No. 6020884 (hereinafter MacNaughton).

5. As per claim 19, MacNaughton teaches a method of providing access to hypertext documents in a multi-user computer environment, the method comprising:

6. (a) tracking accesses to a plurality of preexisting hypertext documents by a plurality of users, (e.g. col. 7, line 57 – col. 8, line57);

7. (b) notifying a first user that is currently accessing one of the plurality of preexisting hypertext documents of the identity of a second user that is accessing the same hypertext document, (e.g. col. 7, line 57 – col. 8, line57);

8. (c) associating a second hypertext document with the second user in response to user input from the second user, (e.g. col. 7, line 57 – col. 8, line57 & col. 9, line 27 – col. 10, line 32); and

9. notifying the first user of the association of the second hypertext document with the second user, (e.g. col. 7, line 57 – col. 8, line57 & col. 9, line 27 – col. 10, line 32);

10. wherein associating the second hypertext document with the second user includes storing an identifier for the second hypertext document in a list of favorite links associated with the second user, wherein notifying the first user of the association of the second hypertext document with the second user includes displaying the list of favorite links to the first user, and wherein the

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method further comprising building a list of favorite links associated with the hypertext document being viewed by the first user by combining lists of favorite links associated with only those users currently viewing the same hypertext document as the first user, (e.g. col. 3, line 24 – col. 5, line 15).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 5 – 8, 13 – 18, 20 – 22, 25 – 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacNaughton et al. (6020884) (hereinafter MacNaughton) in view of Suzuki et al. (6240443) (hereinafter Suzuki).

13. As per claim 1, MacNaughton teaches a method of providing access to hypertext documents in a multi-user computer environment, the method comprising:

14. (a) tracking accesses to a plurality of preexisting hypertext documents by a plurality of users, (e.g. col. 7, line 57 – col. 8, line 57);

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15. (b) notifying a first user that is currently accessing one of the plurality of preexisting hypertext documents of the identity of a second user that is accessing the same hypertext document, (e.g. col. 7, line 57 – col. 8, line57); but does not specifically teach

16. (c) maintaining on behalf of the first user a saved user list that identifies at least the second user such that the first user is notified of the identify of any user in the saved user list that is accessing the same hypertext document, wherein maintaining the saved user list includes at least one of adding a third user to the saved user list and removing the second user from the saved user list in response to user input received from the first user. Suzuki teaches maintaining on behalf of the first user a saved user list that identifies at least the second user such that the first user is notified of the identify of any user in the saved user list that is accessing the same hypertext document, wherein maintaining the saved user list includes at least one of adding a third user to the saved user list and removing the second user from the saved user list in response to user input received from the first user, (e.g. col. 56, lines 46 – 61). It would have been obvious to one of ordinary skill in the art to combine Suzuki with MacNaughton because it would be more efficient if the first user could edit their list so to add new users that could contribute to his internet activities, i.e. new friend to chat with, and to get delete users that are no longer using the same system as the first user, therefore, aiding in keeping an updated list.

17. As per claim 2, MacNaughton teaches tracking accesses to the plurality of preexisting hypertext document includes maintaining a list of users that access each hypertext document, and wherein notifying the first user includes notifying the first user of the identity of each user in the list of users, (e.g. col. 7, line 57 – col. 8, line57).

18. As per claim 5, MacNaughton teaches tracking accesses to the hypertext document further includes removing from the list of users a user that is no longer accessing the hypertext document, (e.g. col. 9, lines 5 – 24).

19. As per claim 6, MacNaughton teaches wherein the second user has a home hypertext document associated therewith, the method further comprising communicating to the first user a copy of the home hypertext document associated with the second user in response to user input from the first user, (e.g. col. 7, line 57 – col. 8, line57).

20. As per claim 7, MacNaughton teaches a method of providing access to hypertext documents in a multi-user computer environment, the method comprising:

21. (a) tracking accesses to a plurality of preexisting hypertext documents by a plurality of users, (e.g. col. 7, line 57 – col. 8, line57);

22. (b) notifying a first user that is currently accessing one of the plurality of preexisting hypertext documents of the identity of a second user that is accessing the same hypertext document, (e.g. col. 7, line 57 – col. 8, line57); but does not specifically teach

23. (c) notifying the first user of the location of another hypertext document currently being viewed by a third user. Suzuki teaches notifying the first user of the location of another hypertext document currently being viewed by a third user, (e.g. col. 9, line 23 – col. 10, line 34). It would have been obvious to one of ordinary skill in the art to combine Suzuki with MacNaughton because if the first user desired to change users to communicate with and/or view a different

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topic that interests the first user it would be more convenient to be able to view other users that would be in different hypertext documents.

24. As per claim 8, MacNaughton teaches communicating to the first user a copy of the hypertext document currently being viewed by the third user, (e.g. col. 7, line 57 – col. 8, line 57).

25. As per claim 13, MacNaughton teaches wherein notifying the first user of the identity of the second user includes notifying the first user of whether the second user is currently active in the multi-user computer environment, (e.g. col. 21, lines 4 – 24).

26. As per claim 14, MacNaughton teaches performing a predetermined list management operation on the user list in response to user input from the first user, the predetermined list management operation selected from the group consisting of sending a message to a user in the user list, navigating to a hypertext document currently being viewed by a user from the user list, and navigating to a home hypertext document for a user from the user list, (e.g. col. 9, lines 6 – 52).

27. As per claim 15, MacNaughton teaches

28. (a) associating a second hypertext document with the second user in response to user input from the second user, (e.g. col. 9, lines 6 – 52); and

29. (b) notifying the first user of the association of the second hypertext document with the second user, (e.g. col. 9, lines 6 – 52).

30. As per claim 16, MacNaughton teaches communicating the second hypertext document to the first user in response to user input from the first user, (e.g. col. 7, line 57 – col. 8, line57).

31. As per claim 17, MacNaughton teaches associating the second hypertext document with the second user includes storing an identifier for the second hypertext document in a list of favorite links associated with the second user, and wherein notifying the first user of the association of the second hypertext document with the second user includes displaying the list of favorite links to the first user, (e.g. col. 7, line 57 – col. 8, line57).

32. As per claim 18, MacNaughton teaches displaying the list of favorite links is performed responsive to user input received from the first user while the first and second users are currently viewing the same hypertext document, (e.g. col. 7, line 57 – col. 8, line57).

33. As per claim 20, MacNaughton teaches

34. (a) associating a second hypertext document with a first hypertext document in response to user input from the second user, (e.g. col. 7, line 57 – col. 8, line57); and

35. (b) notifying the first user of the association of the second hypertext document with the first hypertext document, (e.g. col. 7, line 57 – col. 8, line57).

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36. As per claim 21, MacNaughton teaches associating the second hypertext document with the first hypertext document includes temporarily associating the second hypertext document with the first hypertext document such that the association therebetween is discarded whenever the second user is not active in the multi-user computer environment, (e.g. col. 7, line 57 – col. 8, line57).

37. As per claim 22, MacNaughton teaches tracking accesses to the plurality of preexisting hypertext documents is performed in a first computer, and wherein at least a portion of the plurality of preexisting hypertext documents are stored externally from the multi-user computer environment, (e.g. col. 7, line 57 – col. 8, line57).

38. As per claim 25, MacNaughton teaches an apparatus, comprising:

39. a memory, (e.g. col. 21, lines 10 – 25); and

40. a program, resident in the memory, the program configured to track accesses to a plurality of preexisting documents by a plurality of users, to notify a first user among the plurality of users that is currently accessing one of the plurality of preexisting hypertext documents of the identity of a second user among the plurality of users that is accessing the same hypertext document(e.g. col. 6, lines 1 – 12), and to maintain on behalf of the first user a saved user list that identifies at least the second user such that the first user is notified of the identify of any user in the saved user list that is accessing the same hypertext document, (e.g. col. 7, line 57 – col. 8, line 57 & col. 9, line 53 – col. 10, line 35), but does not specifically teach wherein the program is configured to maintain the saved user list by performing at least one of adding a third

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user to the saved user list and removing the second user from the saved user list in response to user input received from the first user. Suzuki teaches wherein the program is configured to maintain the saved user list by performing at least one of adding a third user to the saved user list and removing the second user from the saved user list in response to user input received from the first user, (e.g. col. 7, lines 32 – 63 & col. 9, line 23 – col. 10, line 34). It would have been obvious to one of ordinary skill in the art to combine Suzuki with MacNaughton because it would be more efficient if the first user could edit their list so to add new users that could contribute to his internet activities, i.e. new friend to chat with, and to get delete users that are no longer using the same system as the first user, therefore, aiding in keeping an updated list.

41. As per claim 26, MacNaughton teaches the program is further configured to maintain a list of users that access each hypertext document, and to notify the first user of the identity of each user in the list of users, (e.g. col. 7, line 57 – col. 8, line 57).

42. As per claim 27, MacNaughton teaches the second user has a home hypertext document associated therewith, the program further configured to communicate to the first user a copy of the home hypertext document associated with the second user in response to user input from the first user, (e.g. col. 8, line 58 – col. 9, line 52).

43. As per claim 28, MacNaughton teaches the program is further configured to retrieve a navigation history for the second user, the navigation history including a set of hypertext documents previously accessed by the second user, (e.g. col. 8, lines 10 – 57).

44. As per claim 29, MacNaughton teaches the memory is disposed in a server computer, the apparatus further comprising a client computer coupled to the server computer, (e.g. col. 21, line 52 – col. 22, line 14), the client computer including a second memory and a second program resident in the second memory, the second program configured to display a first hypertext document to the first user, the first hypertext document including a hypertext link to a second hypertext document that is in the navigation history for the second user, the second program further configured to display within the first hypertext document an indication that the second hypertext document is in the navigation history for the second user, (e.g. col. 3, line 41 – col. 4, line 27).

45. As per claim 30, MacNaughton teaches the program is further configured to associate a second hypertext document with the second user in response to user input from the second user, (e.g. col. 7, line 57 – col. 8, line 57); and to notify the first user of the association of the second hypertext document with the second user, (e.g. col. 7, line 57 – col. 8, line 57).

46. As per claim 31, MacNaughton teaches the program is further configured to store an identifier for the second hypertext document in a list of favorite links associated with the second user, (e.g. col. 7, line 57 – col. 8, line 57).

47. As per claim 32, MacNaughton teaches the program is further configured to build a list of favorite links associated with the hypertext document being viewed by the first user by

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combining lists of favorite links associated with each user currently viewing the same hypertext document as the first user, (e.g. col. 7, line 57 – col. 8, line57).

48. As per claim 33, MacNaughton teaches the program is further configured to associate a second hypertext document with a first hypertext document in response to user input from the second user, and to notify the first user of the association of the second hypertext document with the first hypertext document, (e.g. col. 7, line 57 – col. 8, line57).

49. As per claim 34, MacNaughton teaches the program is further configured to temporarily associate the second hypertext document with the first hypertext document such that the association therebetween is discarded whenever the second user is not active, (e.g. col. 7, line 57 – col. 8, line57).

50. As per claim 35, MacNaughton teaches further comprising a first computer within which the memory is disposed, wherein the program is configured to retrieve at least a portion of the plurality of preexisting hypertext documents from a second computer remote from the first computer and external from the apparatus, (e.g. col. 7, line 57 – col. 8, line57).

51. As per claim 36, MacNaughton teaches the second computer is coupled to the first computer over the Internet, (e.g. col. 7, line 57 – col. 8, line57).

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52. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacNaughton (6020884) in view of Suzuki (6240443) in further view of, "Chat Comp: Lobby", Yahoo!, <http://chat.yahoo.com>, downloaded 11/18/98, (hereinafter Yahoo).

53. As per claim 3, MacNaughton and Suzuki do not specifically teach notifying the first user of the identity of each user in the list of users includes displaying the list of users to the first user. Yahoo teaches notifying the first user of the identity of each user in the list of users includes displaying the list of users to the first user, (Yahoo page 2). It would have been obvious to one skilled in the art at the time the invention was made to combine Yahoo with the combine system of MacNaughton and Suzuki because it is easier and more pleasing to the eye to see a user on a list on a Web page then in a database.

54. As per claim 4, MacNaughton and Suzuki do not teach notifying the first user of the identity of each user in the list of users includes separately notifying the first user of each user from the list of users that is no longer accessing the hypertext document. Yahoo page 1 and Yahoo page 2 teaches notifying the first user of the identity of each user in the list of users includes separately notifying the first user of each user from the list of users that is no longer accessing the hypertext document. It would have been obvious to one skilled in the art at the time the invention was made to combine Yahoo with the combine system of MacNaughton and Suzuki because the first user would not have to search for a user to find out if the second user is accessing the hypertext document. The first user would only need to look at the updated list.

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55. Claims 9, 11, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacNaughton (6020884) in view of Konno (6333787).

56. As per claim 9, MacNaughton teaches a method of providing access to hypertext documents in a multi-user computer environment, the method comprising:

57. (a) tracking accesses to a plurality of preexisting hypertext documents by a plurality of users, (e.g. col. 7, line 57 – col. 8, line57);

58. (b) notifying a first user that is currently accessing one of the plurality of preexisting hypertext documents of the identity of a second user that is accessing the same hypertext document, (e.g. col. 7, line 57 – col. 8, line57), but does not specifically teach wherein tracking accesses to the hypertext document further includes maintaining a navigation history for the second user, the navigation history including a set of hypertext documents previously accessed by the second user, and wherein the method further comprises notifying the first user of the set of hypertext documents in the navigation history for the second user. Konno teaches wherein tracking accesses to the hypertext document further includes maintaining a navigation history for the second user, the navigation history including a set of hypertext documents previously accessed by the second user, and wherein the method further comprises notifying the first user of the set of hypertext documents in the navigation history for the second user, (e.g. col. 4, lines 44 – 64). It would have been obvious to one skilled in the art at the time the invention was made to combine Konno with MacNaughton because it would be more convenient for users viewing the same web page to view other user's web navigation history that might have view other web sites

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that pertain to or similar to a topic of a web site that all of the users are viewing or trying to locate.

59. As per claim 11, MacNaughton teaches a method of providing access to hypertext documents in a multi-user computer environment, the method comprising:

60. (a) tracking accesses to a plurality of preexisting hypertext documents by a plurality of users, (e.g. col. 7, line 57 – col. 8, line57);

61. (b) notifying a first user that is currently accessing one of the plurality of preexisting hypertext documents of the identity of a second user that is accessing the same hypertext document, (e.g. col. 7, line 57 – col. 8, line57), but does not specifically teach wherein tracking accesses to the hypertext document further includes maintaining a navigation history for the second user, the navigation history including a set of hypertext documents previously accessed by the second user, and wherein the method further comprises displaying a first hypertext document to the first user, the first hypertext document including a hypertext link to a second hypertext document that is in the navigation history for the second user, wherein displaying the first hypertext document includes displaying within the first hypertext document and in association with the hypertext link an indication that the second hypertext document is in the navigation history for the second user, (e.g. col. 9, line 53 – col. 10, line 32). Konno teaches wherein tracking accesses to the hypertext document further includes maintaining a navigation history for the second user, the navigation history including a set of hypertext documents previously accessed by the second user, and wherein the method further comprises displaying a first hypertext document to the first user, the first hypertext document including a hypertext link

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to a second hypertext document that is in the navigation history for the second user, wherein displaying the first hypertext document includes displaying within the first hypertext document and in association with the hypertext link an indication that the second hypertext document is in the navigation history for the second user, (e.g. col. 4, lines 44 – 64). It would have been obvious to one skilled in the art at the time the invention was made to combine Konno with MacNaughton because it would be more convenient for users viewing the same web page to view other user's web navigation history that might have view other web sites that pertain to or similar to a topic of a web site that all of the users are viewing or trying to locate.

62. As per claim 12, MacNaughton teaches displaying the indication includes displaying the hypertext link to the second hypertext document in a color associated with the second user, (e.g. col. 8, line 58 – col. 9, line 5).

63. Applicant's arguments with respect to claims 1 – 9, 11 – 22 and 25 – 36 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

64. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

65. a. DeSimone et al. U.S. Patent No. 6212548 discloses System and method for multiple asynchronous text chat conversations.

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66. b. Perkowitz et al. U.S. Patent No. 6138128 discloses Sharing and organizing world wide web references using distinctive characters.

67. c. Herz U.S. Patent No. 6029195 discloses System for customized electronic identification of desirable objects.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are none for regular communications and none for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is none.

David E. England
Examiner
Art Unit 2143

De *DC*
July 9, 2003


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100